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December 19, 2006

Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Art Unit 2855

Attn: Mail Stop Appeal Brief - Patents

Re: U.S. Utility Patent Application
Application No. 10/646,720; Filed: August 25, 2003
For: **High-Resolution Gas Gauge Proximity Sensor**
Inventor: Joseph H. Lyons
Our Ref: 1857.2030000

Sir:

Transmitted herewith for appropriate action are the following documents:

1. Reply Brief Under 37 C.F.R. §41.41; and
2. Return postcard.

It is respectfully requested that the attached postcard be stamped with the date of filing of these documents, and that it be returned to our courier.

In the event that extensions of time are necessary to prevent abandonment of this patent application, then such extensions of time are hereby petitioned.

The U.S. Patent and Trademark Office is hereby authorized to charge any fee deficiency, or credit any overpayment, to our Deposit Account No. 19-0036.

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.

Jason D. Eisenberg
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JDE/la
Enclosure(s)



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Joseph H. Lyons

Application No.: 10/646,720

Filed: August 25, 2003

For: **High-Resolution Gas Gauge
Proximity Sensor**

Confirmation No.: 9846

Art Unit: 2855

Examiner: Michael T. Cygan

Atty. Docket: 1857.2030000

Reply Brief Under 37 C.F.R. § 41.41

Mail Stop Appeal Brief - Patents

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Appellant filed a Brief on Appeal to the Board of Patent Appeals and Interferences for the above-captioned application on July 13, 2006, appealing the decision of the Examiner in the Final Office Action mailed December 13, 2005. Appellant filed a Modified Brief on Appeal August 23, 2006, which was in response to a Notification of Non-Compliant Appeal Brief mailed August 4, 2006. The Examiner's Answer was mailed on October 19, 2006. In reply to the Examiner's Answer, Appellant submits this Reply Brief Under 37 C.F.R. §41.41.¹

¹ Appellant notes the Examiner's Answer refers to page numbers of the Appeal Brief filed July 13, 2006, and not the Modified Appeal Brief filed August 23, 2006. Appellant will use the Appeal Brief page numbers as well for consistency.

A. *The Examiner's Statements Regarding the Non Analogous Arts Test are in Error and Must be Reversed*

1. *Claim 19 Includes Features Argued In The Appeal Brief*

Appellant maintains their position that Zumbach and Carreras are non analogous art to the claimed invention. Moreover, the applied references do not teach or suggest each feature of Appellant's independent claims. Appellant further disagrees with the Examiner's interpretation of the case law, claimed invention, applied references, and Appellant's arguments, as set forth in the Examiner's Answer.

The Examiner indicates in the Response to Argument at page 12 of the Examiner's Answer that:

First, while appellant places emphasis on the "claimed invention," appellant argues features that are not in at least some of the claims. Most significantly is appellant's reliance on air gauge as appellant's field of endeavor when claim 19 does not mention that term. Appellant also refers to the field of endeavor as "nanometer level measurements" despite the lack of such a limitation in the claims.

Appellant believes this to be misdirected. First, the section on page 14 in the Appeal Brief the Examiner refers to is directed to the "reasonably pertinent to the particular problem" prong of the non analogous test, not the "field of endeavor" prong. The Appellant's arguments for the "field of endeavor prong" are found on page 13 of the Appeal Brief. In the "field of endeavor" arguments on page 13 of the Appeal Brief, Appellant has asserted the "field of endeavor" as including, for example, "using an elongated nozzle to make measurements in a similar way as a differential gas gauge sensor." This is clearly recited in claim 19. Thus, the Appellant's arguments are not in error.

Further, Appellant disagrees with the Examiner's assertions concerning the "reasonably pertinent to the particular problem," statements found in the Appeal Brief at page 14. The Appellant has stated on page 14 of the Appeal Brief:

The claimed invention is directed to making nanometer level measurements of standoffs between respective measuring and reference nozzles and measurement and reference surfaces using a differential air gauge sensor having an elongated nozzle.

In claim 19, the process of making these measurements is recited without relying on structural limitations because claim 19 is a method claim. However, claim 19 recites language supported by the instant specification that makes it clear the Appellant is performing the process using the air gauge described in the instant specification. Thus, Appellant's arguments are not in error.

2. *Appellant's Believe The Non Analogous Art Test Is Restricted To The Claimed Invention*

In regards to the Examiner's arguments regarding the claims not reciting "nanometer level measurements," Appellant asserts that the dimensions as claimed for the elongated nozzle support making nanometer level measurements as argued. Appellant's also assert that the applied references cannot achieve the same level of resolution, even assuming, arguendo, they teach or suggest allegedly analogous nozzles. Thus, Appellant's arguments are not in error.

In regards to the Examiner's arguments that Appellant improperly relies on the "claimed invention" for the non analogous art test, stating "Such a narrow reading is inconsistent with the broad terms of Oetiker ... and Clay," the Appellant disagrees. As already discussed by the Appellant at page 14 of the Appeal Brief, which entire argument is incorporated by reference herein, Appellant believes *In re Clay* stated that the claimed invention was an important restriction in determining the "reasonably pertinent to the particular problem" prong of the non analogous art test. Further, as Appellant argues on page 13 of the Appeal Brief, which entire argument is incorporated by reference herein, Appellant believes *In re Bigio* clarified the scope of the "field of endeavor" test, such that this prong should be analyzed in the context of the claimed invention. Thus, Appellant's arguments are not in error.

B. *The Examiner's Statements Regarding the Appellant's Focus on the Inventor's Problem are in Error and Must be Reversed*

Appellant maintains their position that applied references do not teach the problem solved by the claimed invention. Thus, the applied references do not teach or suggest each feature of Appellant's independent claims. Appellant further disagrees with the Examiner's interpretation of the case law, claimed invention, applied references, and Appellant's arguments.

In the Examiner's Answer, the Examiner relies on *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985), to rebut Appellant's that neither Zumbach nor Carreras attempt to solve the same problem as the claimed invention. The Examiner states:

The fact that the appellant has recognized another advantage which would flow naturally from following the suggestions of the prior art cannot be a basis for patentability when the differences would otherwise be obvious.

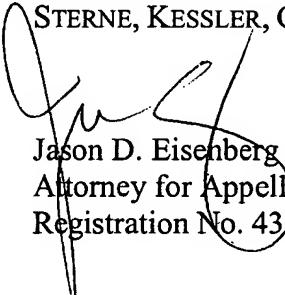
First, Appellant does not believe the claimed invention "naturally flows" from the suggestions in the applied references, as required by *Ex parte Obiaya*. In this regard, the Examiner has not met the burden of showing otherwise, since the Examiner merely quotes the passage from the M.P.E.P without applying the case law to the facts of the pending application. Second, the holding in *Ex parte Obiaya* appears to assume the applied references teach the claimed invention, and appellant is relying on secondary considerations (e.g., unexpected results argued in the cited case) for patentability. The Appellant is not relying on secondary considerations in the prosecution of the instant application, as is demonstrated in the various arguments supplied by Appellant in the Appeal Brief. Thus, because the Examiner has failed to meet the burden of proving the elements set forth in *Ex parte Obiaya*, the Examiner's reliance on *Ex parte Obiaya* appears misplaced.

C. Conclusion

In light of the arguments above, as well as those set forth in Appellant's Brief on Appeal filed July 13, 2006 and Appellant's Modified Appeal Brief filed August 23, 2006, Appellant respectfully submits that the final rejections of claims 19-25 and 39-52 are improper and should be reversed.

Respectfully submitted,

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Date: 12/19/06

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